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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,438	01/23/2004	Andrew M. Hatch	HSTI 0135 PUS1/H50006AHST	6831
35312 7590 10/17/2008 BROOKS KUSHMAN P.C./ HENKEL CORPORATION 1000 TOWN CENTER TWENTY-SECOND FLOOR SOUTHFIELD, MI 48075-1238				
EXAMINER DOUYON, LORNA M				
ART UNIT		PAPER NUMBER		
1796				
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10/17/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/763,438

**Applicant(s)**

HATCH ET AL.

**Examiner**

Lorna M. Douyon

**Art Unit**

1796

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10, 13, 14, 16-18 and 80-95 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 13, 14, 16-18 and 80-95 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/808)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

1. This action is responsive to the amendment filed on June 30, 2008.
2. Claims 1-10, 13-14, 16-18, 80-95 are pending. Claims 80-95 are newly added.
3. The objection to claim 64 is withdrawn in view of applicants' cancellation of this claim.
4. Claims 1-10, 13-14, 16-18, 80-95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li et al. (US Patent No. 6,214,777), hereinafter "Li" for the reasons set forth in the previous office action.
5. The remaining prior art rejections are withdrawn in view of Applicants' amendment.

***Claim Objections***

6. Claims 1 and 80 are objected to because of the following informalities: in claim 1, line 7, and claim 80, line 7, the term "ethoxylate" (second occurrence) is misspelled. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

7. Claims 18 and 95 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 18 and 95, the proportions of each of the ethoxylate of an alcohol and surfactant are outside the range of claims 1 and 80, respectively.

***Claim Rejections - 35 USC § 103***

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 1-5, 7-10, 13-14, 16-18, 80-85, 87-95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yianakopoulos (US Patent No. 5,462,697).

Yianakopoulos teaches a cleaning composition for cleaning hard surfaces in the form of a dilute oil-in-water microemulsion which comprises about 0.1 to about 15% of a water-mixable nonionic surfactant, 1% to 10% of at least one organic acid cosurfactant, and 10% to 85% of water, said proportions being based upon the total weight of the composition (see col. 4, lines 3-23; 40-52; col. 8, lines 27-29). The nonionic surfactant includes the condensation products of a higher alcohol (e.g., an alkanol containing about 8 to 18 carbon atoms in a straight or branched chain configuration) condensed with about 5 to 30 moles of ethylene oxide (see col. 8, lines 47-51). The pH of the microemulsion cleaner is usually 1-5, preferably 1-4, and more preferably 1.5-3.5 (see col. 14, lines 60-62). Yianakopoulos, however, fails to specifically disclose (1) a cleaning

composition wherein the ethoxylate of an alcohol has 12 to 80 carbon atoms and 20 to 80 mole ethoxylate, and which has a pH of less than 2 as required in independent claims 1 and 80 (2) a cleaning composition having an average water-break-free percent reduction of less than 50% after 7 days aging as required in claims 1 and 81; (3) a cleaning composition which is capable of cleaning an exterior wall of an aluminum can such that the percent of total surface area of the exterior wall which supports a continuous film of water is greater than 50% after the aluminum can is cleaned with the cleaning composition as required in claims 3 and 83, (4) the cloud point of the cleaning composition as required in claim 2; (5) the ethoxylate of an alcohol having 20 carbon atoms as required in claims 10 and 90; and (6) the ethoxylate of an alcohol having a mixture of straight and branched alkyl as required in claims 7 and 87.

With respect to difference (1), it would have been obvious to one of ordinary skill in the art at the time the invention was made to select the portion of the prior art's range which is within the range of applicant's claims because it has been held to be obvious to select a value in a known range by optimization for the best results. As to optimization results, a patent will not be granted based upon the optimization of result effective variables when the optimization is obtained through routine experimentation unless there is a showing of unexpected results which properly rebuts the *prima facie* case of obviousness. See *In re Boesch*, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980). See also *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936-37 (Fed. Cir. 1990), and *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). In addition, a *prima facie* case of obviousness exists because the claimed ranges "overlap

or lie inside ranges disclosed by the prior art", see *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976; *In re Woodruff*, 919 F.2d 1575, 16USPQ2d 1934 (Fed. Cir. 1990). See MPEP 2131.03 and MPEP 2144.05I.

With respect to difference (2), it would have been obvious to one of ordinary skill in the art at the time the invention was made to reasonably expect the composition of Yianakopoulos to exhibit a water-break-free percent reduction of less than 50% because similar components having overlapping proportions have been utilized.

With respect to difference (3), it has been held that the recitation that an element is "adapted to" perform or is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. The recitation of a new intended use for an old product does not make a claim to that old product patentable, see *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997).

With respect to difference (4), it would have been obvious to one of ordinary skill in the art at the time the invention was made to reasonably expect said property to be within those recited because similar ingredients have been utilized.

With respect to difference (5), a *prima facie* case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties, see *Titanium Metals Corp. of America v. Banner*, 778F.2d 775,227 USPQ 773 (Fed. Cir. 1985). See MPEP 2144.051.

With respect to difference (6), the combination of the straight and branched chains in the nonionic surfactant of Yianakopoulos (see col. 8, lines 47-51) is likely to be obvious when it does no more than yield predictable results.

### ***Response to Arguments***

10. Applicants' arguments filed June 30, 2008 have been fully considered but they are not persuasive.

With respect to the obviousness rejection based upon Li, Applicants argue that the lower endpoint for both surfactants was lowered such that the lower value of the range is non determinative in overcoming the Li reference.

The Examiner respectfully disagrees with the above arguments because in col. 7, lines 26-30, Li teaches about 0.5 to about 30 percent by weight of nonionic surfactants which overlaps those recited, i.e. alkoxyated alcohols having the general formula  $R^{10}O((CH_2)_mO)_n$  wherein  $R^{10}$  is an aliphatic group having from about 8 to about 24 carbon atoms, m is a whole number from 1 to about 5, and n is a number from 1 to about 40 which represents the average number of ethylene oxide groups on the molecule (see col. 7, lines 18-25). Also, in col. 7, lines 50-53, Li teaches that the total surfactant concentration ranges from about 1 wt% to 50 wt%. The word "about" permits some tolerance (see *In re Ayers*, 69 USPQ 109, and *In re Erickson*, 145 USPQ 207), hence, the lower limit of about 0.5 weight percent nonionic surfactant, and about 1 wt% total surfactants of Li may be considered to read on the upper limit of about 3g/l (about 0.3 wt%) of the present claims.

***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lorna M. Douyon whose telephone number is 571-272-1313. The examiner can normally be reached on Mondays-Fridays 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lorna M Douyon/  
Primary Examiner, Art Unit 1796